

REMARKS

Claims 1-3 are pending in this application. Via the present submission, claim 3 is amended.

Applicants appreciate the courtesy extended by the Examiner-of-record for promptly granting the telephone interview of September 24, 2003 to discuss the prosecution of the present application. In accordance with MPEP § 713.04, applicants herein make of record the substance of the interview. The content is presented below at various points as appropriate.

Initially during the interview, the undersigned informed the Examiner that claim 3 inadvertently recites "V-shaped (39)" in line 17, where "V-face (39)" is preferable. The Examiner indicated that he would enter an amendment to correct this informality.

As shown above, applicants amend claim 3 to recite "V-face (39)" in line 17 in place of "V-shaped (39)." Entry of the amendment is hereby requested.

Claim 1 stands rejected under 35 U.S.C. § 102(a) as anticipated by **Yagasaki et al.** (U.S. Patent No. 6,334,830). Applicants respectfully traverse this rejection as improper.

This rejection was discussed extensively during the September 24, 2003 interview. Initially, when the Examiner realized that the applied prior art, **Yagasaki et al.** (U.S. Patent No. 6,334,830), was a patent assigned to the assignee of the subject application, he suggested that we act to overcome the rejection by filing a statement that the patent and the application have the same assignee. In support of this suggestion, the Examiner e-mailed to the undersigned a memorandum dated November 4, 2002 that was distributed in the U.S. Patent and Trademark Office (PTO). The

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memorandum discussed PTO procedures regarding 35 U.S.C. § 102. Such effort by the Examiner to advance prosecution is greatly appreciated.

However, the PTO memorandum discusses 35 U.S.C. § 102(e), and claim 1 is rejected under 35 U.S.C. § 102(a). Accordingly, the memorandum does not appear to support a method of overcoming the present rejection by filing a statement that the patent and the application have the same assignee. Anyway, because claim 1 recites features that are not taught by **Yagasaki et al.**, applicants can overcome the rejection by providing an explanation of the distinctions between the claim and the prior art.

As then discussed in the interview, claim 1 describes a belt for a continuously variable transmission with an element body such that “the folding-resistant strength of the element body (34) is uniform laterally.” The undersigned stated during the interview that **Yagasaki et al.** does not teach this feature. (The undersigned also referred to the marked-up copy of the first page of the patent, which was provided in the Office Action. The undersigned reiterated that a rejection cannot rely on drawings as evidence of proportions. See MPEP § 2125.)

The next interview topic was the statements provided in the June 26, 2003 Office Action on page 3, in the ***Response to Arguments*** section.

The first referenced statement from the Office Action was the following:

Applicant contended that although Yagasaki et al. supposedly anticipates the claim structural elements, there is not explanation as to how the folding resistant strength of the body (3) is uniform laterally.

The undersigned explained in the interview that applicants never contended that **Yagasaki et al.** anticipates the claim structural elements, because the claim specifies that the folding-resistant strength of the element body is uniform laterally, and applicants had argued that **Yagasaki et al.** did not teach this feature. Applicants regard the laterally uniform folding-resistant strength as a “characteristic” of the claimed belt. This characteristic describes structure, and prior art that does not teach this characteristic cannot anticipate the structural element recited in the claim.

The Examiner took the position that the recited characteristic does not describe structure, as discussed below.

Next during the interview, the undersigned referenced the following statement from the Office Action (page 3, paragraph No. 6):

In response, it should be noted that if the prior art meets structural limitations of the claim, then the structure is capable of performing or obtaining the same intended use or result.

The undersigned explained applicant's position that the prior art does *not* meet the structural limitations of the claim, so the structure is not capable of performing or obtaining the same intended use or result. It was further explained that the referenced claimed feature is not an “intended use.”¹ It was also explained that claimed feature was not an “intended” result; instead, the feature is an *actual* result.

The Examiner explained that he would not give patentable weight to the claim recitation “the folding-resistant strength of the element body (34) is uniform laterally,” because the claims did not

¹The undersigned provided the example recitation, “an element body for abutting a pulley,” which in certain circumstances might be interpreted as a recitation of intended use. Such a recitation is quite different from the recitation in the claim.

further describe how this characteristic is achieved. Applicants' representative acknowledged that 35 U.S.C. § 112, first paragraph, requires that the *specification* describe how this characteristic is achieved, but 35 U.S.C. § 102 (upon which the rejection is based) does not require that the *claim* provide this description.

The statute 35 U.S.C. § 102 requires that the prior art teach every element in the claim, expressly or inherently, to properly anticipate the claim, and the Manual of Patent Examining Procedure (MPEP) states this requirement in section 2131 (page 2100-70). However, the Examiner stated in the interview that he only needed to consider "structure."² He believed that, if Yagasaki et al. taught the other elements of the claim, then inherently it must also teach that "the folding-resistant strength of the element body (34) is uniform laterally" as claimed.

Applicants respectfully disagree. During the interview, the undersigned used an analogy in an attempt to persuade the Examiner that the above-described understanding was incorrect. The analogy was the following:

Suppose a claim for a box reads as follows:

A box comprising:
six sides;
wherein the interior of the box is air-tight.

Applicants representative asked the Examiner, if he had a prior art teaching of a box with six sides, but the prior art had no explicit statement that the interior was air-tight, would he believe that the prior art *inherently* taught that the interior was air-tight. The Examiner responded that he would

²As explained above, the recited characteristic that "the folding-resistant strength of the element body (34) is uniform laterally" is a description of structure. As also noted above, the Examiner disagrees.

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believe that the air-tight feature was inherent. For example, the hypothetical claim does not recite that the box is sealed.

Applicant's representative did expect this response, because a air-tight characteristic of a prior art box does not change based on how a patent applicant writes a claim. It is not true that any box with six sides is air tight. The air-tight characteristic of a prior art box does not extinguish if a patent applicant amends a claim a certain way.

Analogously, whether **Yagasaki et al.** teach a belt with an element body such that "the folding-resistant strength of the element body (34) is uniform laterally" is a determination that is independent of what a claim recites. Stated differently, this characteristic does not become inherent if a particular amendment to the claim is effected.

However, the Examiner took the opposite position. He said during the interview that the MPEP supports his position, but he did not indicate which section of the MPEP supposedly provides this support. Applicants request that he provide the cite to this appropriate section.

In view of reasons presented above, applicants request reconsideration of the anticipation rejection. If the Examiner remains convinced that the rejection is proper, applicant respectfully request that he provide the supposed basis in the MPEP (discussed in the preceding paragraph) and that he also indicate which parts of the applicants' reasoning above is supposedly flawed.

Nonetheless, applicants appreciate the opportunity afforded by the Examiner to discuss the rejection during the September 24, 2003 interview. Even if the remarks above do not persuade the Examiner to withdraw the anticipation rejection, prosecution still benefits by placing the description of the contested issues on the record. The Examiner is welcome to contact applicants' undersigned

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attorney at the telephone number indicated below if he believes an additional discussion would be worthwhile.

In the event that this paper is not timely filed, applicants petition for an appropriate extension of time. The fees for such an extension, or any other fees which may be due, may be charged to Deposit Account No. 01-2340.

Respectfully submitted,
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